



## UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/509,853	06/08/00	DE CAGNY	R RSA254AUS

REMY J VANOPHEM  
THOMAS A MEEHAN  
755 W BIG BEAVER ROAD  
SUITE 1313  
TROY MI 48084-4903

PM82/0905

EXAMINER	
STORMER, R	
ART UNIT	PAPER NUMBER
3617	13
DATE MAILED: 09/05/01	

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/509,853</b>	Applicant(s) <b>DeCagny et al</b>	
	Examiner <b>Russell Stormer</b>	Art Unit <b>3617</b>	
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>			
<b>Period for Reply</b>			
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p>			
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>			
<b>Status</b>			
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Jun 28, 2001</u>			
2a) <input checked="" type="checkbox"/> This action is FINAL.      2b) <input type="checkbox"/> This action is non-final.			
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.			
<b>Disposition of Claims</b>			
4) <input checked="" type="checkbox"/> Claim(s) <u>1-28</u> is/are pending in the application.			
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.			
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.			
6) <input checked="" type="checkbox"/> Claim(s) <u>1-28</u> is/are rejected.			
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.			
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.			
<b>Application Papers</b>			
9) <input type="checkbox"/> The specification is objected to by the Examiner.			
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.			
11) <input checked="" type="checkbox"/> The proposed drawing correction filed on <u>Jun 28, 2001</u> is: a) <input checked="" type="checkbox"/> approved b) <input type="checkbox"/> disapproved.			
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.			
<b>Priority under 35 U.S.C. § 119</b>			
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).			
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____ 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).			
*See the attached detailed Office action for a list of the certified copies not received.			
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).			
<b>Attachment(s)</b>			
15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____	
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)	
17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>10</u>		20) <input type="checkbox"/> Other: _____	

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***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the balancing device that is mounted to the "inside" of the sidewall of the tire as set forth in claim 24 must be shown or the feature canceled from the claim. No new matter should be entered.

***Specification***

2. The substitute specification filed June 28, 2001 is approved and entered.

3. The specification is objected to under 37 CFR 1.75(d)(1) as failing to provide proper antecedent basis for the claimed subject matter. There is no description of a balancing device being mounted on the inside of the tire sidewall as set forth in claim 24.

See MPEP § 608.01(o).

***Claim Objections***

4. Claim 20 is objected to because of the following informalities: The "wheel" claimed in the preamble should be changed to --wheel assembly-- since the claim is directed to a wheel, a tire, and a balancing device and not just a wheel. Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

5. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 claims the balancing device to be mounted along the *outside* of the sidewall of the tire, but depends from claim 24 which claims the balancing device to be mounted on the *inside* of the sidewall of the tire. It is not clear how the device can be mounted to both sidewalls, and the claim is therefore too indefinite to examine on the merits.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 7, 8, 9, 10, 11, 12, 14, 17, 20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Woolson.

Woolson discloses a tire balancing weight comprising a weight 10 embedded or encased in a member 8 which is mounted to the tire. The member 8 is considered to be a case as broadly recited, and the member is vulcanized to the tire. To be vulcanized to the tire the case must be melted to some degree, and therefore the side of the case which is directly joined to the tire would

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comprise the means for mounting the case to the tire sidewall. Though formed of linked members, the weight 10 is considered to be a single weight.

8. Claims 20 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Thissen et al (EPO 222391; newly cited).

The balancing weight 1 is encased in rings 30, 70 which form a case around the weight. The balancing device is mounted firmly to a surface of a side 28 of the tire as it is wedged in place.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 4, 6, 18, 19, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolson.

Woolson meets all of the limitations of claim 1 as set forth in paragraph 6 above but the material of the weight is not specifically set forth as being iron alloy or zinc and aluminum alloy. However, at lines 62-64 of page 1, Woolson describes the weights or links 10 as being made of any suitable material. Such suitable materials would include iron alloy (steel) and aluminum and zinc alloys since those of ordinary skill in the art would readily know that such material would

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perform well as balancing materials and would further be resistant to weather and would also be less poisonous than lead.

With respect to claim 6, the device would inherently include a convex surface during flexing of the tire.

With respect to claims 18 and 19 the color of the case is not patentable.

With respect to claim 21, to mount at least one device on each side of the tire would have been obvious to those of ordinary skill in the art in as needed to balance the tire.

With respect to claim 24, to mount the device on the inside of the tire would have been obvious in order to hide the device. The device would balance the tire just the same.

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11. Claims 13, 15, 16, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolson in view of Turoczi Jr..

To use an adhesive or glue to mount the device to the tire would have been obvious as taught by Turoczi Jr.. as such is well-known and would be a simpler and less expensive alternative to the vulcanization used by Woolson.

12. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woolson in view of Flebbe (German 3632981; newly cited).

For the tire to include a circumferential groove for the reception of the balancing device would have been obvious as taught by Flebbe. Note the grooves in the tire, the spacer, and between the two as shown in figure 1 of Flebbe.

*Response to Arguments*

13. Applicant's arguments filed June 28, 2001 have been fully considered but they are not persuasive.

Because the balancing weight of Woolson is encased in the patch-like member 8, the weight is enclosed in a case. The articulated links 10 comprise a single weight in the assembled device of the links and the case. Note lines 75-85 which state that other forms of weight may be used.

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***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other wheel and tire balancing weights.

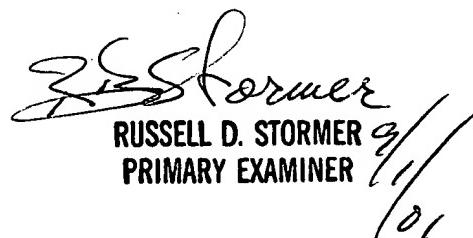
15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-3768.

rds

September 1, 2001

  
RUSSELL D. STORMER  
PRIMARY EXAMINER  
9/1/01